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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,064	08/21/2001	James Peter Herrick	88265-7079	7759
28765	7590	12/08/2003	EXAMINER	
WINSTON & STRAWN PATENT DEPARTMENT 1400 L STREET, N.W. WASHINGTON, DC 20005-3502			BHAT, NINA NMN	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/935,064

### Applicant(s)

HERRICK ET AL.

### Examiner

N. Bhat

### Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 1-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-50 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-25, drawn to an apparatus, classified in class 222, subclass 61+.
  - II. Claims 26-41, drawn to a method of dispensing, classified in class 222, subclass 1.
  - III. Claims 42-50, drawn to a food product, classified in class 426, subclass 590.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP§806.05(g)). In this case the apparatus as claimed can be used to make materially different product for example, the apparatus can be used for dispensing soft serve ice cream and need not be used for making a yogurt based beverage.

3. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP§806.05(e)). In this case the apparatus as claimed can be used to practice a different process for example, the apparatus for dispensing can be used in making different non-food type dispensing applications, i.e., the apparatus as claimed can be used for

dispensing pharmaceutical or preparing pharmaceutical compositions or cosmetic compositions.

4. Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP§806.05(f)). In the instant case the product can be made by another and materially different process, i.e., the layered colored product can be dispensed using a plurality of different nozzles having different streams of food compositions which are deposited in a clear container to make a layered product.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and the search required for any one group is not required for the other groups, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Mr. Allan Fanucci on November 18, 2003 a provisional election was made with traverse to prosecute the invention of group III, claims 42-50. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-41 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Action on the merits of claims 42-50 follows:

Claims 43, 49 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 43, has used the linking term "preferably" which links a broad range with narrower range. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 43 recites the broad recitation of bleeding for two layers together at least

two minutes after dispensing, and the claim also recites "preferably at least 5 minutes after dispensing" which is the narrower statement of the range/limitation. Applicant should draft a dependent claim, which depends from claim 43, which recites the narrower range of at least 5 minutes after dispensing in order to obviate the rejection.

In claim 49 applicant recites wherein one of the components is a culinary component, in claim 42 from which claim 49 depends, the claim recites a food product which contains portions of at least two visually distinct food components, the recitation of 49 that one of the components is a culinary component does not further limit claim 42 and further is redundant. Applicant is suggested to delete claim 49.

In claim 50, applicant recites that the portion is a portion suitable for serving a group. It is unclear what applicant meant in claim 42, applicant recites that the spoonable or drinkable food product is viewable through a container; the container is generic which can read on an individual portion or a group portion. It is not clear what applicant means by serving suitable for serving a group. Suitable explanation and/or correction is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 42-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Daravigas et al.

Daravigas et al. teach yogurt products in a container having a plurality of layers portions or regions each having a discrete color comprising a stirred style yogurt. The layered yogurt is specially prepared to prevent bleeding and migration of colorants between layers and mixing upon handling. Daravigas et al. teach providing a fruit puree on one color and then providing a second yogurt or another color dispensed into a container. The first stage includes charging yogurt to the bottom of a suitable container. The second stage is adding a second layer or portion charged to the partially filled container, the second layer is characterized by having a visually apparent distinct color at lest hue difference. The second layer can have the same or different composition of the first layer. The layers do not migrate nor the colors bleed and have a shelf life of 60 days. [Note Column 10, lines 7-67] Daravigas et al. teach that the simplest and most preferred style is providing a "parfait style" yogurt/fruit composition which has layers, which are, arranged one atop the other forming a vertically stacked series of horizontally extending layers. Another arrangement referred to as the "Neopolitan style" the orientation is rotated 90 degrees to form a horizontally stacked series of vertically extending layers. In another embodiment a "bull's eye" style, the product is in the form of concentric rings about a central core. Other embodiments include the "barber pole" style wherein the yogurt portions are in the form of intermeshed spirals. The multicolored stirred style yogurt/fruit product are highly visually distinctive and appealing which maintain the visually distinct features for the full duration of ordinary shelf life

approximately 60 days with out unacceptable migration of colorants among the plurality of phases.[Note Column 11, lines 6-42] The yogurt as described by Daravingas et al. fully anticipates applicant's claims as presently drafted.

10. Claims 42-45 and 48-50 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 1 040 759.

EP 1 040 759 teaches providing two-layered yogurt product in a container comprising a sauce on top of yogurt. The boundary between the sauce and the yogurt is clearly distinguished. [Note the abstract and Figure 2]. Specifically, the two-layered yogurt is prepared by filling a container with a yogurt composition and then dispensing a sauce on top of the yogurt layer. The layers do not become turbid during the production process or in storage and the sauce and yogurt do not mix during the distribution phase and during storage the layers are clearly separate and visually distinct. The layered yogurt as described by EP 1 040 759 anticipate applicant's claims.[Note Page 2 Lines 39-58, also note Page 5, line 40 et seq.]

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stussi teach preparing a fruit on the top sundae style yogurt. Baker et al. teach a low fat custard type yogurt product and method. Powrie et al. teach a formulation and process for producing universal fruit base in preparing no settling creamy, smooth fruit beverages. EP 0 002 037 teach a method for filling containers with sundae style yogurt.




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Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. Bhat whose telephone number is 703-308-3879. The examiner can normally be reached on Monday-Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.

  
N. Bhat  
Primary Examiner  
Art Unit 1761

November 30, 2003